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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 10/607,102   | 06/25/2003  | Lutz Rosenpflanze    | 13907-058001/2003E00251 | 3609             |
| 32864  | 7590        | 05/19/2006           | D                       |                  |
| FISH & RICHARDSON, P.C.<br>PO BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      |                         |                  |
| EXAMINER   |             |                      |                         |                  |
| HILLERY, NATHAN  |             |                      |                         |                  |
| ART UNIT   |             |                      | PAPER NUMBER            |                  |
| 2176   |             |                      |                         |                  |
| DATE MAILED: 05/19/2006  |             |                      |                         |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                                      |  |  |
|---|--------------------------------------|--|--|
| <b>Advisory Action</b><br><b>Before the Filing of an Appeal Brief</b> | <b>Application No.</b><br>10/607,102 | <b>Applicant(s)</b><br>ROSENPFANZER ET AL. |  |
|   | <b>Examiner</b><br>Nathan Hillery    | <b>Art Unit</b><br>2176                    |  |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

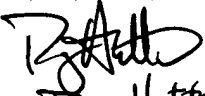
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-29.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
Doug Hutton  
Primary Examiner  
Tech Center 2100

Continuation of 3. NOTE: The proposed amendments seek to not only overcome the 112 rejections under the first and second paragraphs but also the cited art of record. Because these proposed amendments significantly change the scope and potentially raise new issues under 35 USC 112, further search and/or consideration is needed.

Continuation of 11. does NOT place the application in condition for allowance because:

Regarding the rejection(s) made under 35 USC 101, it should be noted that the Office meant to convey that claims 1 - 29 recite functional descriptive material with no practical application and/or fail to produce a useful, concrete, tangible result. Specifically, claims 1 - 14 do not produce a result at all; thus failing to produce a concrete, tangible, useful result. Further, as outlined in the Interim Guidelines for Subject Matter Eligibility, the Office has detailed a new interpretation. Under this new interpretation, the claims must provide a practical application of judicial exception by either a physical transformation or the production of a concrete, useful, tangible result. The Office contends that claims 1 - 29 do not produce any result at all. Further, it should be noted that mapping, disclosed by applicant to be a transformation, might be a data transformation but is definitely not a physical transformation. Physical transformation occurs when the claimed invention transforms an article or physical object to a different structural state or thing.

Regarding claims 15 - 29, again the Interim Guidelines for Subject Matter Eligibility provides a detailed explanation, specifically outlining how the Office is currently interpreting information carrier such as signals on pp 55 - 57, Annex IV(c). Applicant discloses that an information carrier can be a propagated signal (Specification, p 13, line 16); therefore, according to the interim guidelines, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101. Also, these interim guidelines propose that such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of § 101.

Regarding the rejection under 35 USC 112, first paragraph, it should be noted that simply limiting the scope of the limitation does not adequately address the issues under 112, first paragraph. Any negative limitation or exclusionary proviso must have basis in the original disclosure. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. (MPEP 2173.05(i))

Regarding the rejections under 35 USC 102, Applicant's arguments are significantly directed towards the newly amended claim language as a whole and would require further search and/or consideration. However, according to the limitations rejected in the final rejection, Granade clearly anticipates:

receiving information describing a first representation of data variable information in a data variable (locale variable in the application) in a first data processing system (backend system 102); receiving information describing a second representation of the data variable (selected locale information) in the second data processing system (mobile device 106); and mapping (correlating) the first representation of the data variable information to the second representation of the data variable information in the absence of input